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Amendment
Attorney Docket No. S111.2H-9524-US

Remarks

This amendment is in response to the Office Action mailed May 23, 2003 in which claims 1-15 were rejected under 35 USC §103. Applicant has amended claim 1 to overcome the rejection, and canceled claims 8 and 9.

35 USC §103 rejection over Magaton in view of Vezzani

1 - 4:

In the Office Action, claim 1 is rejected as being obvious under 35 USC §103 over U.S. Patent No. 2,040,700 ("Magaton") in view of U.S. Patent No. 5,902,520 ("Vezzani"). The Office Action states that Magaton "teaches [a] two section cylindrical particulate separator divided by a separator plate (i.e. the unit of Figure 4 divided by screen 90)". Applicant respectfully traverses the rejection and asserts that screen 90 of Magaton is not a separator plate as claimed in the instant application. The specification of the Magaton '700 patent does not teach, suggest, or disclose that the screen 90 is a substantially solid separator plate which restricts the chamber 34 by providing a circular plate to substantially block the passage between the centrifuge 14 and the blender 16. The Magaton '700 reference also fails to suggest, teach, and/or disclose that the screen 90 is further constructed and arranged to allow the drive shaft 76 to pass through it. Webster's dictionary defines a screen as "a coarse mesh of wire for sifting", or in Magaton, for filtering. One of ordinary skill in the art would recognize that a screen is not a substantially solid separator plate as claimed within the instant invention.

There is no teaching, suggestion, or motivation in Magaton, either explicitly or implicitly, to provide radially extending members, comprising a support shaft and a paddle, the members having the same length in the first section, and radially extending members, comprising a support shaft and a paddle, the members having another length in the second section, the length of the members in the second section less than the length of the members of the first section. There is no teaching, suggestion, or motivation in the art as a whole to combine Magaton with any other reference to provide radially extending members, comprising a support shaft and a paddle, the members having the same length in the first section, and radially extending members,

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comprising a support shaft and a paddle, the members having another length in the second section, the length of the members in the second section less than the length of the members of the first section.

Furthermore, Vezzani teaches a separator comprising one chamber, with a plurality of radially extending members of one length. Vezzani also teaches using cones attached to the drive shaft along with the radially extending members of one length. The Office Action argues that "Vezzani teach[s] radially extending members throughout the separator and teach[s] varying designs and sizes (e.g. blades and cones wherein the cones are radially longer...)". Applicant respectfully submits that the cones of Vezzani are not radially extending members comprising a support shaft a paddle as claimed in the instant application.

In view of the above, Applicant respectfully asserts that there is no teaching, suggestion, or motivation in Vezzani, Magaton, or any combination thereof, either explicitly or implicitly, to provide a particulate separator comprising a cylindrically shaped chamber, with a first and second section, and a plurality of radially extending members, comprising a support shaft and a paddle, the members having the same length in the first section, and radially extending members, comprising a support shaft and a paddle, the members having another length in the second section, the length of the members in the second section less than the length of the members of the first section.

Applicant respectfully further asserts that combining the references would not produce the claimed invention of the instant application. Combining the two references would result in an apparatus significantly different structurally than the instant claims; the alleged combination comprising filtering elements, cones, and radially extending members of varying lengths in a cylindrical section, the radially extending members without paddles. In order for the combination of Magaton and Vezzani to be made, the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). In *Hodosh v. Block Drug Co.*, the Federal Circuit set out several guiding principles in regards to obviousness determinations under 35 USC §103. (*Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 187 (Fed. Cir. 1986)). One well

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understood principle set forth in *Hodosh v. Block Drug Co.* being that a *prima facie* case of obviousness has not been established if the intended purpose or function of either of the references is destroyed by their combination (*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). If the cones of Vezzani are used in the alleged combination with Magaton, one of ordinary skill in the art would recognize that the gas would be accelerated to such a speed that it would not adequately be kept "in continuous agitation together with the liquid lying at the bottom of the chamber 23 by agitating blades 85, so that the gaseous substances are kept in continuous contact with the liquid and the wet surfaces of the blades", as designed in Magaton. (See Magaton, page 3, column 1, lines 51-56). Conversely, if the cones of Vezzani are replaced by radially extending members "of any particular size or design", as suggested in the Office Action, in the alleged combination with Magaton, the increase in the velocity of the gas, as desired in Vezzani, would not occur. The cones are needed in Vezzani in order to force "the gas...to pass through the extremely narrow gap between the base of the cone 9 and the inner wall of the body 1." (see Vezzani, column 3, lines 8-13). Therefore, combining Vezzani with Magaton in the manner suggested in the Office Action would most likely destroy the functionality of either or both the devices. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection pursuant to 35 USC §103 in view of the associated combination of Magaton and Vezzani.

5 - 8:

In regards to the Examiner's rejections of claims 4 and 8-11, Applicant respectfully submits that "dependent claims are nonobvious under 35 USC §103 if the independent claims from which they depend are nonobvious." (*Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987)). As claims 4, 10, and 11 of the instant application depend from amended independent claim 1, Applicant respectfully requests that the Examiner allow claims 4, 10, and 11 in view of the above. Applicant has canceled claims 8 and 9.

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35 USC §103 rejection (continued)

9 – 12:

In the Office Action, claims 2, 5-7, and 12-15 were rejected under 35 USC §103 as being unpatentable over Magaton in view of Vezzani as applied to claims 1, 4, and 8-11 above, further in view of U.S. Patent No. 4,213, 571 ("Deardorff"). In view of the arguments presented above, Applicant respectfully submits that the teachings of Deardorff are moot because combining Magaton with Vezzani alone, for the purposes of 35 USC §103, fails to produce the particulate separator of the instant application. Furthermore, it should be noted that method claim 13 requires the particulate capture system of claim 1. Since the references cited in the Office Action fail to teach or suggest all of the elements of claim 1, the references cited also fail to teach or suggest all of the elements of the method as described in claim 13. Applicant respectfully requests that the Examiner reconsider and withdraw the rejections and allow claims 2, 5-7, and 12-15 in view of the above.

35 USC §103 rejection (further continued)

13 – 15:

In the Office Action, claim 3 is rejected under 35 USC §103 as being unpatentable over Magaton in view of Vezzani further in view of Deardorff, as applied to claims 2, 5-7, and 12-15 above, further in view of U.S. Patent No. 2,770,543 ("Arnold"). In view of the arguments presented above, Applicant respectfully submits that the teachings of Arnold are moot because combining Magaton with Vezzani alone, for the purposes of 35 USC §103, fails to produce the particulate separator claimed in instant application. Applicant respectfully requests that the Examiner reconsider and withdraw the rejections and allow claims 3 in view of the above.

Applicant has presented amended claims herein in order to expedite prosecution of the instant application. Applicant intends to pursue the scope of the original claims and/or broader claims within a continuation application, and as such, Applicant submits any amendments herein without prejudice with respect to the broadest available scope of claims for Applicant's invention.

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Formalities

Applicant recognizes that a one-month extension is required to make the response timely. PTO-2038 Form is enclosed authorizing the one month extension fee of \$55.00 to be charged to Applicant's Attorney's Credit Card. However, if a further extension of time is required to make this response timely and no separate petition is enclosed, Applicant hereby petitions for an extension of time sufficient to make the response timely. **In the event that this response requires the payment of any government fees and payment is not enclosed, then please charge any and all required fees to Deposit Account No. 22-0350.**

Conclusion

It is believed that claims 1-7 and 10-15 are in condition for allowance in view of the foregoing. Applicant respectfully requests reconsideration of the claims herein and an early allowance of the claims. The Applicant respectfully requests that the Examiner enter the amendment which Applicant believes puts the application in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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